

**REMARKS**

Claims 1-3, 5-9, 17, 19 and 20 are pending in this application. Claims 4, 10-16 and 18 have been cancelled. Claims 1, 17 and 19 have been amended. Claims 1 and 17 are independent claims.

In an Office action dated July 14, 2003, all of the pending claims were rejected under 35 U.S.C. 103(a). Independent claims 1 and 17 were rejected as allegedly being unpatentable over Tombetti in view of Sells et al. Independent claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti in view of Kikinis et al. Dependent claims 2 and 3 were rejected as being unpatentable over Tombetti in view of Sells et al. and further in view of Dunn et al., while other dependent claims were rejected as being unpatentable over Tombetti in view of the combination of Kikinis et al., Sells et al. and Yeh et al.

In order to place the claims in a better condition for consideration upon appeal, Applicants have amended independent claims 1 and 17 and have cancelled independent claim 10 and its dependent claims. The cancellation of claim 10 reduces the issues to be considered upon appeal, since the two remaining independent claims have a common basis for rejection (i.e., Tombetti in view of Sells et al.) Similarly, the amendments to claims 1 and 17 reduce the issues. Claim 1 has been amended to incorporate the subject matter of claim 4 as originally filed, while claim 17 has been amended to incorporate the features of claim 18. The amendments do not introduce new subject matter and do not present additional issues for consideration. Applicants respectfully request that the amendments be entered.

**A. Request for Explanation**

Applicants note with appreciation that some of the remarks previously filed by Applicants were directly addressed in the portion of the Office action entitled

“Response to Arguments.” However, the most fundamental (in terms of the guidelines set for a Section 103(a) determination) argument presented by Applicants in both of the previous two amendments has not been addressed. Specifically, Applicants respectfully assert that the rejection of the two pending independent claims necessarily relies upon interweaving teachings of Tombetti that cannot logically coexist. The rejection of the independent claims interweaves the teachings regarding the “conventional” approach (separate telephones and computers) with the inventive approach of Tombetti (a unit that provides the benefits of both a computer and a telephone, as illustrated in Fig. 2 of the patent). The inventive approach of using a single unit is incompatible with the conventional approach of using separate telephone and computer systems. Yet, the rejection of method claims 1 and 17 cites the teachings of one approach (column 3 of Tombetti) as describing selected steps of Applicants’ pending claims and cites the teachings regarding the incompatible approach (columns 5 and 8) as describing other claimed steps.

In order to enable Applicants to make an informed decision as to the next step in the prosecution of the application and in order to allow Applicants to present a focused Appeal Brief if the appeal process is selected, it is respectfully requested that the Examiner comment on fundamental conclusions of Applicants. The basis for each conclusion will be stated in the sections that follow. Specifically, the Examiner’s position on each of the following is requested:

Conclusion 1: Column 3 of Tombetti teaches a conventional approach in which telephones and computers function separately.

Conclusion 2: Columns 5 and 8 of Tombetti describe the use of the multimedia phone system 100 shown in Fig. 2, which is identified as being inventive relative to the conventional approach of column 3.

Conclusion 3: Those paragraphs of the Sells et al. patent that are cited in the Office action as being relevant to the determination of the patentability of claim 1 only refer to components of a personal computer, rather than to components of a telephone and components of a personal computer.

Conclusion 4: By itself, the description in column 3 of Tombetti does not teach or suggest a step of “determining, within a telephone, whether first call-related data received at the telephone will be stored in the telephone memory located within the telephone or in computer memory located within the computer.

Conclusion 5: The multimedia phone system described in columns 4-8 of Tombetti does not include a telephone that is enabled to perform telephone functions independently of a computer while being able to determine whether call-related data received at the telephone is to be stored in a computer memory (claim 1) and/or is to be processed by the processor of a computer (claim 17).

Applicants agree that the conventional approach (column 3) of Tombetti is relevant prior art in determining the patentability of the pending claims. Applicants also agree that the description of the invention of Tombetti (columns 4-8) is relevant prior art in determining the patentability of the pending claims. However, it is respectfully asserted that a *prima facie* case of obviousness under Section 103(a) has not been presented when the rejection relies upon mutually inconsistent teachings.

B. Conclusion 1 – Column 3 of Tombetti Teaches a Conventional Approach That Is Fundamentally Different than the Inventive Approach Described in Columns 4-8 of the Patent

Independent claims 1 and 17 include steps of determining, within a telephone, whether call-related data received at the telephone is to be stored in telephone or computer memory (claim 1) or is to be processed using the telephone’s processor or a computer’s processor (claim 17). The Office action

cites column 3 of Tombetti for allegedly teaching this step in which a telephone determines operations by a computer. However, column 3 describes the "conventional" approach and specifically states that "conventional computers and phone systems function separately" (Tombetti: column 3, lines 50-51).

In the section of the Tombetti patent entitled "BRIEF DESCRIPTION OF THE DRAWINGS," Fig. 1 (which is described in column 3) is identified as a conventional system, while Fig. 2 (which is described in columns 4-8) is identified as one embodiment of the inventive multimedia phone. The illustration of the conventional system in Fig. 1 does not include any telephone-determined storage to a computer and does not include any telephone-determined processing within a computer.

In the first full paragraph of column 3, Tombetti states that the then current major technologies for exchanging information included computers and telecommunication devices (such as telecommunication terminals). The second full paragraph of column 3 states that some of the telecommunication terminals are capable of providing limited computing functions and may have the capability of communicating with a computer, such as to allow a user to access certain online services. Fig. 1 shows the telephone 10 as being connected to a computer 18 through a communication line 14. However, neither the limited computing functions of the telephone nor the ability to communicate with the computer teaches or suggests receiving first call-related data at the telephone and then determining within the telephone whether to store (or to process) the call-related data at the telephone or the computer.

The third full paragraph of column 3 of Tombetti states that the user may also have access to a "separate computer (not shown)." The paragraph concludes that because the user is able to use a computer and a telecommunications terminal (telephone 10), the user can perform many different tasks. Thus, the user (and not the telephone) determines whether call-related data is to be stored and/or processed within the telephone or the computer. It is inaccurate to cite the third full paragraph of column 3 as teaching that the

determination is made within the telephone.

In the lead sentence of the final full paragraph in column 3 of Tombetti, it is stated that the conventional computers and telephone systems function separately. The paragraph then identifies the separate drawbacks of the two systems. Thus, the four paragraphs of column 3 are consistent with respect to teaching the separate functioning of the computer system and the phone system. The description of the conventional approach states that the phone is able to communicate with the computer, but not in the manner described in independent claims 1 and 17.

C. Conclusion 2 – The Multimedia Phone System Described in Columns 5 and 8 of Tombetti Is Structurally and Operationally Different Than the Use of Separate Phone and Computer Systems, as Described in Column 3 of the Same Patent

Column 5 of Tombetti describes the multimedia phone system 100 shown in Fig. 2 of the patent. The system includes a corded or cordless telecommunications terminal 102 and includes a keyboard 106 that is used for dialing telecommunications terminal numbers when the system is used as a conventional phone. Moreover, when the system is provided with the appropriate modules, the system is able to perform a variety of tasks typically performed by a computer.

The main body of the system 100 in Fig. 2 can function as either a telephone or a computer. When used as a telephone, the keyboard 106 of the main body is used to dial the telephone number, but the corded or cordless handset 102 is used by the caller. Thus, the system 100 of Fig. 2 is fundamentally different than the two separate systems described in column 3 of Tombetti. In fact, the purpose of the description of column 3 is to identify the drawbacks that are encountered when the single-system approach of Fig. 2 is not used.

Applicants respectfully request an explanation of the application of the

Tombetti teachings, as applied to the steps of claim 1. The Office action cites column 8, lines 29-35 of Tombetti as teaching the step of enabling the telephone to store call-related data in memory located within the telephone. This portion of column 8 states that additional memory 360 may be included within the system 100. The additional memory 360 may be a memory card that is accessed through the back panel 150 of the main body of the Tombetti invention. Since the memory card is identified as teaching the step of enabling the telephone to store call-related data in the telephone memory, it necessarily follows that the main body of the system 100 is identified as the "telephone" as the basis for the Section 103(a) rejection. However, if the main body of the system 100 is the "memory-enabled telephone," the main body cannot be the "computer." Thus, in the rejection of pending claim 1, column 3 of Tombetti is cited in the Office action with regard to the claimed step of enabling a computer to store the call-related data. Column 3 does state that the telephone 10 is able to communicate with a computer 18 through a communication line 14, such as conventional telephone lines. In the stated example, the telephone 10 can communicate with the computer 18 if the telephone allows access to certain online services. However, the rejection of claim 1 does not provide an explanation as to how column 3 describes the step of enabling a computer to store call-related data in memory, where the call-related data has been received by the telephone, rather than being sent by the telephone.

The Office action agrees that Tombetti does not explicitly disclose the alternative storage, but concludes that since the step is not disclosed, it is "thus" obvious. The basis for the Office action conclusion is that the ordinarily skilled artisan would have been motivated to seek an embodiment in order to provide an actual working arrangement taught by Tombetti. However, the working arrangement taught by Tombetti does not disclose alternative storage and does not teach or suggest an actual working arrangement that provides alternative storage of call-related data received at the telephone.

It is respectfully submitted that the person of ordinary skill in the art would

not be motivated by the Tombetti patent to significantly modify either the "conventional" approach described in the patent or the "inventive" approach of Tombetti in order to more closely approach Applicants' claimed invention. In view of the amendments to claims 1 and 17, Applicants submit that the remaining pending claims are allowable over the prior art.

D. Conclusion 3 – The Cited Paragraphs of Sells et al. Refer Only to Components of a Personal Computer, Rather Than Components of a Telephone and Components of a Personal Computer

The Office action cites the patent to Sells et al. in modifying the Tombetti teachings. Applicants respectfully assert that Sells et al. is consistent with Tombetti in not teaching alternative storage. Moreover, Sells et al. teaches that determinations for a telephone are made within a computer system, rather than determinations that storage or processing within a computer should be made within the telephone.

The Office action cites four paragraphs within the Sells et al. patent. The first paragraph begins in column 2, line 35. This paragraph specifically states that the objects of the Sells et al. invention are provided by a method for processing an incoming call over a telephone line in a computer system. The remainder of the paragraph refers to programs and applications within the computer, rather than any storage or processing within a telephone.

The second paragraph of Sells et al. cited in the Office action is the one that begins on line 59 in column 3. This paragraph describes some of the components of the personal computer 12. The personal computer includes a memory subsystem 31 and a telephony subsystem 14. The telephony subsystem 14 of the personal computer 12 receives incoming calls and transmits outgoing calls over a telephone line 22. Since this paragraph of Sells et al. only describes the personal computer, the paragraph should not be read to describe a telephone.

The third cited paragraph in Sells et al. is found in column 4, lines 39-43. This paragraph describes how components of the personal computer enable the personal computer to function as an answering machine. Specifically, the paragraph states that the voice storage application program 108 of the personal computer “enables the personal computer 12 to function as an automated telephone answering machine.” This portion of the patent describes elements should in Fig. 4, which is identified in the “BRIEF DESCRIPTION OF THE DRAWINGS” as being the telephony software implemented on the personal computer. The telephony software implemented on the personal computer is described as comprising a telephone manager program and a set of telephony application programs. Thus, the Sells et al. patent is consistent with the teachings of Tombetti in not providing the alternative storage set forth in the pending claims.

The final paragraph cited in the Office action is the one that begins on line 59 in column 8 of Sells et al. Applicants assert that the patent teaches that the telephone manager program 104, which is part of the “telephony software implemented on the personal computer,” causes the telephony application interface 110 of the personal computer to transfer control of the telephone line 22 to the appropriate telephony application program, which is also part of the “telephony software implemented on the personal computer.”

Since Sells et al. consistently teaches that the storage of call-related data is to occur within the personal computer 12 and consistently teaches that the personal computer is to make determinations for the telephone (rather than the telephone determining operations of the computer), the Tombetti patent does not render Applicants’ claimed invention obvious, even when modified in view of Sells et al.



E. Conclusion 4 – By Itself, the Description of the Conventional Approach in Column 3 of Tombetti Does Not Teach or Suggest a Step of Determining, Within a Telephone, Whether First Call-related Data Received at the Telephone Will Be Stored in Telephone Memory or Computer Memory

In column 3 of Tombetti, two different computers are mentioned. The first computer is the one illustrated in Fig. 1 as the computer 18 which can be called by the telephone 10 using the communication line 14. For example, the telephone 10 “may allow a user to access certain online services” (Tombetti: column 3, lines 28-30). Since the online computer is accessed using the communication line 14, the interaction with the computer is not one that describes, teaches or suggests determining, within the telephone, whether call-related data received at the telephone will be stored in the telephone memory or the computer memory (claim 1). Similarly, the described interaction between the computer and the telephone does not teach or suggest receiving call-related data at the telephone and determining, using automated processing capabilities of the telephone, whether the call-related data will be processed using the processor of the telephone or the processor of the computer.

The second computer in column 3 of Tombetti is the one identified as the “separate computer (not shown).” The patent does state that the computer can download information from another system for editing on the computer, such as data from a personal digital assistant, but specifically states that the conventional computer “functions separately” from the phone system (Tombetti: column 3, lines 50-51). Thus, the “separate computer” does not store call-related data in memory after a telephone determines that the call-related data at the telephone is to be stored in computer memory, rather than telephone memory (claim 1). In like manner, the separately functioning computer of Tombetti does not process call-related data after the call-related data has been received at the telephone

that uses its automated processing capability to determine that the computer should process the call-related data (claim 17).

Applicants respectfully assert that the amended claims are in an allowable condition.

G. Conclusion 5 – The Multimedia Phone System Described in Columns 4-8 of Tombetti Does Not Include a Telephone that Is Able to Perform Telephone Functions Independently of a Computer, While Being Enabled to Determine Whether Call-related Data Is To Be Stored and/or Processed Via a Computer

The multimedia phone system 100 shown in Fig. 2 and described beginning in column 4 of Tombetti includes a keyboard 106 for dialing a telephone number and includes a handset 102 that may be corded or cordless. Thus, it is Applicants' position that the system 100 of Fig. 2 is a "telephone" with a variety of expanded features and capabilities. The Office action repeatedly cites lines 29-35 in column 8, which state that the system 100 of Fig. 2 may include additional memory in the form of a memory card that is accessed through the back panel of the system. Since the card is merely memory and does not include a processor, the memory card cannot be the "computer memory" of the computer of Applicants' claimed invention. In another cited portion of the Tombetti patent, it is stated that the system can be provided with modules that allow the system to perform "tasks typically performed by a computer" (Tombetti: column 5, lines 54-59). However, this does not teach or suggest using the multimedia phone system 100 of Fig. 2 in Tombetti to determine whether call-related data will be stored and/or processed within a computer or within the multimedia phone system.

Reconsideration of the claims is respectfully requested.

H. Secondary References to Dunn et al., Kikinis et al. and Yeh et al.

Applicants incorporate by reference the comments previously filed regarding the secondary references. Presently, the primary goal is to obtain a full understanding of the Examiner's positions regarding the five conclusions under Heading A above.

I. Extent of Request

While Applicants have provided detail for the various conclusions, Applicants' main intent is to solicit a logical progression of the application of the Tombetti teachings to independent claims 1 and 17. Because the Office action refers to column 3 of Tombetti for selected claimed steps and cites column 5-8 for other claimed steps, and since the description in column 3 is logically inconsistent with the description in claims 5-8, Applicants are at a disadvantage in attempting to succinctly overcome the rejection either via amendment or appeal.

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call Thomas George at (650) 694-5191.

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SIEMENS CORPORATION  
Intellectual Property Department  
170 Wood Avenue South  
Iselin, New Jersey 08830  
ATTENTION: Elsa Keller, IP Department  
Telephone: (732) 321-3026

Respectfully requested,

By: Thomas George  
Thomas George  
Registration No. 45,740  
Attorney for Applicants  
Tel: 650-694-5191  
Fax: 650-968-4517